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# TRANSMITTAL FORM

(to be used for all correspondence after initial filing)

Application Number	10/708,033
Filing Date	February 4, 2004
First Named Inventor	Jed Rose
Art Unit	3711
Examiner Name	Benjamin H. Layno
Attorney Docket Number	014622-000001

Total Number of Pages in This Submission

## ENCLOSURES (check all that apply)

<input type="checkbox"/> Fee Transmittal Form <input type="checkbox"/> Fee Attached <input type="checkbox"/> Amendment / Reply <input type="checkbox"/> After Final <input type="checkbox"/> Affidavits/declaration(s) <input type="checkbox"/> Extension of Time Request <input type="checkbox"/> Express Abandonment Request <input type="checkbox"/> Information Disclosure Statement <input type="checkbox"/> Certified Copy of Priority Documents <input type="checkbox"/> Response to Missing Parts/Incomplete Application <input type="checkbox"/> Response to Missing Parts under 37 CFR 1.52 or 1.53	<input type="checkbox"/> Drawing(s) <input type="checkbox"/> Licensing-related Papers <input type="checkbox"/> Petition <input type="checkbox"/> Petition to Convert to a Provisional Application <input type="checkbox"/> Power of Attorney, Revocation Change of Correspondence Address <input type="checkbox"/> Terminal Disclaimer <input type="checkbox"/> Request for Refund <input type="checkbox"/> CD, Number of CD(s) _____ <input type="checkbox"/> Landscape Table on CD	<input type="checkbox"/> After Allowance Communication to Group <input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences <input checked="" type="checkbox"/> Appeal Communication to Group (Appeal Notice, Brief, Reply Brief) <input type="checkbox"/> Proprietary Information <input type="checkbox"/> Status Letter <input checked="" type="checkbox"/> Other Enclosure(s) (please identify below): <b>*Acknowledgment Postcard</b>
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Remarks

## SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT

Firm Name	MOORE & VAN ALLEN		
Signature			
Printed Name	JENNIFER L. SKORD		
Date	MAY 12, 2006	Reg. No.	30,687

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Typed or printed name	Katie M. Efland	Date	May 12, 2006

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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Appln. No. : 10/708,033  
Appln. Filing Date : February 4, 2004  
  
Inventors : Jed E. Rose, et al.  
Art Unit : 3711  
Examiner: : Benjamin H. Layno  
Docket No. of New Continuation : 014622.000001  
Customer No. : 24239  
Title : CARD GAME

Confirmation No.: 2032

Commissioner for Patents  
P.O. Box 1450  
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*Katie M. Efland*  
Katie M. Efland

**RESPONSE TO EXAMINER'S ANSWER IN APPEAL**

Sir:

This is responsive to the March 14, 2006 Examiner's Answer, having a 2-month deadline of May 14, 2006 for filing a Response. Since May 14, 2006 is a Sunday, the actual deadline is:

**May 15, 2006.**

***Summary of withdrawal/maintenance of rejections in Examiner's Answer.***

In the Examiner's Answer, the Examiner withdrew the rejection of Claims 1 – 11 as being non-statutory subject matter under 35 USC §101.

Also in the Examiner's Answer, the Examiner maintained the rejection of Claims 1 – 11 under 35 USC §102(b) as being anticipated by U.S. Patent No. 5,417,432 to Dwyer.

Also in the Examiner's Answer, the Examiner maintained the rejection of Claims 12 – 27 under 35 USC §103(a) as being unpatentable over U.S. Patent No. 5,547,199 to Calhoun, in view of U.S. Patent No. 4,637,799 to Bouchal.

***Discussion of rejection of claims 1 - 11 under 35 USC §102(b) as being anticipated by U.S. Patent No. 5,417,432 to Dwyer.***

Appellants' product claims 1 - 11 require that the playing cards comprise two suits where the first suit comprises threat cards and the second suit comprises tool cards.

In the Examiner's Answer, the Examiner reiterated the same anticipation rejection under 35 USC §102(b) in view of Dwyer, and again asserted that Dwyer shows two card suits because the borders of the Dwyer cards have a minor variance in color. Specifically, the Examiner stated:

However in Dwyer, there are two suits, but the cards of the first suit are the same as the cards of the second suit, with only a minor variance in border color. ... The Examiner takes the position that the Appellants' arguments are based on how the appellants define a suit, and how the Appellant's [*sic*, Appellants] interpret the printed matter on the cards to distinguish the first suit from the second suit. [Emphasis supplied.]

Appellants respectfully point out that the Examiner has ignored that Dwyer specifically states that provided is a:

card deck that has duplicate letter cards for matching that are *void of ... traditional card suit markings....*[Emphasis supplied.]

at lines 20 – 23 of column 4 of Dwyer.

Benjamin Layno, the Examiner for the present application, is the SAME Examiner as for Dwyer (see, front page of Dwyer), and thus, appellants respectfully point out that the Examiner ought to be aware that Dwyer specifically defines her card game as NOT having two suits.

**Accordingly, the Examiner has imposed his own definition of two card suits into the teachings of Dwyer in order to come up with the presently claimed invention.**

Moreover, the Dwyer cards have on them the letters "A" to "Z" of the alphabet; none of the Dwyer cards have threats on them and none of the Dwyer cards have tools on them.

Appellants reiterate, as the Examiner should be aware, for a reference to be a reference under any paragraph of §102, that reference, *by itself*, must teach each and every element of the claimed invention. That is not achieved by Dwyer by itself.

Furthermore, appellants respectfully reiterate that the Examiner has misinterpreted when a mere arrangement of printed matter is not patentable subject matter.

As is clear from the court cases that appellants discussed in their Appeal Brief, differences between the claimed invention and the prior art cited against it cannot be ignored merely because those differences reside in the content of printed matter.

Appellants respectfully submit that the Examiner is ignoring the differences between appellants' claimed playing cards and the playing cards of Dwyer merely because those differences reside in the content of printed matter.

Appellants have clearly explained the differences between their playing cards and the playing cards of Dwyer, and the Board is respectfully referred to the discussion of the court cases in appellants' Appeal Brief.

Accordingly, the Board is respectfully requested to instruct the Examiner withdraw the rejection under §102(b) of claims 1 - 11, with regard to U.S. Patent No. 5,417,432 to Dwyer.

***Discussion of rejection of claims 12 - 27 under 35 USC §103(a) as being obvious over U.S. Patent No. 5,547,199 to Calhoun, in view of U.S. Patent No. 4,637,799 to Bouchal.***

As discussed in appellants' December 20, 2004 Response to the first Office Action and in their Appeal Brief, appellants once more respectfully point out that the Examiner in the Examiner's Answer again has ignored that Calhoun requires that the sentence on the sentence card and the picture on the picture card are *already predetermined to inherently relate to each other*, and thus, a player selects a sentence card and at least one picture card, and then explains that *predetermined* relationship of the picture on the picture card to the sentence on the sentence card, and again has ignored that Bouchal requires arranging a plurality of picture cards into a matrix array that is a logical sequence so that the player can tell a story based on what the matrix arrangement means.

In contrast, for appellants' method as claimed, a player takes a threat card and a tool card, *makes up a story* for how the cards relate, and scores 0 to a selected number of points for the story. There is no predetermined relationship between the tool card and the threat card, and there is no plurality of cards arranged into a matrix.

Appellants once again respectfully point out that this it is impermissible in a §103(a) rejection for the Examiner to ignore certain teachings of a reference, and instead pick and choose only what the Examiner likes from a reference. As the Examiner should be well aware, such ignoring of teachings of a reference amounts to an impermissible hindsight argument.

Also, in the Examiner's Answer, the Examiner once again stated that:

In response to applicant's [*sic*, applicants'] arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references.

This is exactly what the Examiner previously stated in the second Office Action.

Contrary to the Examiner's allegation, appellants have indeed argued the combination of Calhoun and Bouchal.

Appellants again respectfully point out that the Examiner has once again made an incorrect assertion and once again has completely ignored that appellants argued the combination. Appellants' arguments about the combination of Calhoun and Bouchal are set out in appellants' December 20, 2004 Response to the first Office Action, and repeated verbatim on page 21 of appellants' Appeal Brief.

Appellants' arguments about the combination of Calhoun and Bouchal are again reiterated here:

If Calhoun and Bouchal '799 were combined, then the resultant would be a matrix of cards with sentences such that the matrix of cards tells its own story. All the player would do is read the story from the matrix of cards, and there would be no need for creativity on the part of the player. This is a teaching away from applicants' claimed method. Furthermore, applicants respectfully point out that it well known law that it is improper to ignore certain teachings of the references, as the references must be considered as a whole with respect to the claimed invention as a whole.

Thus, Calhoun and Bouchal, either alone or in any combination whatsoever, do not teach or suggest each and every element of the claimed invention, as claimed in claims 12 - 27.

Accordingly, the Board is respectfully requested to instruct the Examiner withdraw the rejection under §103(a) of claims 12 - 27, with regard to U.S. Patent No. 5,547,199 to Calhoun, in view of U.S. Patent No. 4,637,799 to Bouchal.

## CONCLUSIONS

Appellants respectfully submit that, in view of the comments above and the comments in appellants' Appeal Brief, all claims are allowable, and the Board is respectfully requested to direct the Examiner to withdraw the various rejections under 35 USC §102(b) and 35 USC §103(a).

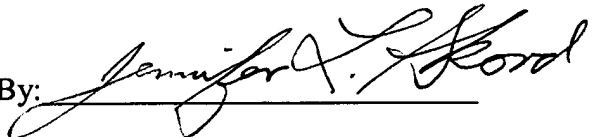
Accordingly, appellants respectfully submit that the case is in condition for allowance and early allowance is earnestly solicited, and the Board is respectfully requested to direct the Examiner to allow all claims and issue a Notice of Allowance for the present application.

## DEPOSIT ACCOUNT

Although it is believed that no fee is due for the instant Response to Examiner's Answer, the Commissioner is authorized to charge any deficiencies of payment associated with this Communication, or to credit any overpayment, to **Deposit Account No. 13-4365**.

Date: May 12, 2006

Respectfully submitted,

By: 

Jennifer L. Skord  
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